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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Peter Wung Confirmation No. 9010
Serial No.: 10/712,597
Filed: November 13, 2003 Customer No.: 28863
Examiner: Dana D. Greene
Group Art Unit: 3762
Docket No.: 1023-232US01
Title: EMERGENCY MEDICAL DEVICES WITH MULTIPLE DISPLAYS

CERTIFICATE UNDER 37 CFR 1.8 I hereby certify that this correspondence is being transmitted via facsimile to the United States Patent and Trademark Office on September 6, 2005.

By: 

Name: JASON B. KEW

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants respectfully request a Pre-Appeal Brief Review, based upon the following grounds:

1. The finality of the Office Action is improper; and
2. The rejections of Applicant's claims are clearly erroneous on the merits.

Some of the details of the Examiner's errors are set forth below. For simplicity, Applicant focuses upon the pending independent claims. By setting forth these clear grounds for error, Applicant does not assert that these are the only errors that the Examiner has made, nor does Examiner waive any arguments that may be asserted in an Appeal Brief.

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The Finality of the Office Action is Improper

The finality of the Office Action is improper, because the Examiner based rejections in the Final Office Action upon new grounds that were not necessitated by amendments made by Applicant, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).¹ The Examiner has given Applicant no opportunity to respond to the new grounds of rejection.

In an Office Action mailed December 9, 2004, the Examiner rejected independent claims 1 and 22 under 35 U.S.C. § 102(b) as anticipated by Titus (USPN 4,404,974 to Titus). In an Amendment dated March 9, 2005, Applicant amended claims 1 and 22 to require that the previously recited first and second display monitors face in different directions. This requirement of amended independent claims 1 and 22 was clearly not disclosed or suggested by Titus.² This requirement was also clearly not disclosed or suggested by the other references applied in the Office Action dated December 9, 2004.³

In response to Applicant's Amendment, the Examiner mailed a Final Office Action on June 6, 2005. In the Final Office Action, the Examiner asserted entirely new grounds for rejection of claims 1 and 22. In particular, the Examiner rejected independent claims 1 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Sellers (USPN 5,896,575 to Sellers) in view of Higginbotham (USPN 5,896,575). These rejections were based on a different statute than had been previously asserted, and entirely different references than had been previously applied. In the Final Office Action, the Examiner admitted that all pending grounds for rejection were new. Although the Examiner declared that the new grounds for amendment were necessitated by Applicants' amendment, this statement is clearly incorrect and unsupported by the record.

Applicant's amendment of claims 1 and 22 to require that the previously recited first and second display monitors face in different directions did not necessitate the new grounds of rejection asserted by the Examiner in the Final Office Action. Issues pertaining to first and second display monitors facing in different directions were previously presented to the Examiner. For example, claims 2 and 23 as originally filed required that a major surface of the first display

¹ MPEP 706.07(a).

² See Amendment dated 3/9/05, page 8, second full paragraph at sentence which begins "It is apparent from FIG. 2 of Titus...."

³ See *id.*, paragraph that begins on page 8, and extends to page 9.

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monitor be arranged in a first plane and a major surface of the second display monitor be arranged in a second plane, and the first plane and the second plane are substantially perpendicular to one another. With the first and second planes substantially perpendicular to each other, the recited first and second display monitors would necessarily face in different directions.

Accordingly, the issues pertaining to first and second display monitors facing in different directions were not raised for the first time by way of Applicant's Amendment of March 9, 2005. On the contrary, these issues should have been a part of the Examiner's original prior art search. If the Examiner failed to take these issues into account in performing the original search, this does not mean that Applicant's amendments necessitated any new grounds for rejection.

In short, Applicant's Amendment of March 9, 2005 did not necessitate the Examiner's new grounds of rejection advanced in the Final Office Action insofar as the Amendment of March 9, 2005 introduced limitations into the independent claims that should have already been addressed in the Examiner's original examination of the dependent claims. For this reason, Applicants request reversal of the finality of the Office Action June 6, 2005.

The Rejections are clearly erroneous

The Examiner's rejections of Applicant's claims are clearly erroneous, because the Examiner omitted one or more essential elements needed for a prima facie case of obviousness under 35 U.S.C. § 103. For a prima facie case of obviousness, the prior art references must teach or suggest all the claim limitations.⁴ Even when combined, the references applied by the Examiner so clearly fail to teach or suggest the requirements of Applicant's independent claims, to amount to a clear legal and factual deficiency in the rejections of Applicant's claims.

Independent claim 1 requires an emergency medical device comprising first and second display monitors to display respective subsets of measured patient parameters, wherein the first and the second display monitors face in different directions. Similarly, independent claim 22 requires a method comprising displaying a first subset of measured patient parameters via a first display monitor of an emergency medical device, and displaying a second subset of the measured patient parameters via a second display monitor of the emergency medical device, wherein the

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first and the second display monitors face in different directions. The applied references clearly fail to disclose or suggest these requirements of Applicant's independent claims.

In the Final Office Action, the Examiner relied on Sellers for disclosure of an emergency medical device comprising first and second display monitors to display respective subsets of measured patient parameters, as required by independent claims 1 and 22. However, the device described by Sellers is a physiological monitor 10 that includes a single user display 16, as clearly indicated in the passage of Sellers cited by the Examiner.⁵ The Examiner appears to have misunderstood the term "physiological monitor" in the Sellers disclosure to refer to a device separate from the user display 16 that is also capable of displaying information. The physiological monitor 10 described by Sellers is not a display monitor, but is instead an ambulatory patient monitoring device, i.e., a Holter monitor, that includes a single user display 16. Sellers does not even suggest that the physiological monitor 10 may have more than one user display 16, as required by Applicant's independent claims.

Further, Sellers does not even suggest that the single user display 16 displays measured patient parameters, as required by Applicant's independent claims. Instead, Sellers merely states that the user display 16 "normally displays the time of day and can be used to provide other status messages to the patient."⁶ Sellers does not teach or suggest that the "other status messages" may include measured patient parameters.

In sum, the Examiner's suggestion that Sellers discloses an emergency medical device comprising first and second display monitors to display respective subsets of measured patient parameters, as required by independent claims 1 and 22, is clearly erroneous. Indeed, the Examiner's interpretation of Sellers is so clearly incorrect, that it is a clear legal and factual deficiency in the Examiner's prima facie case, suitable for resolution by pre-appeal brief review.

Additionally, none of the other applied references provides any teaching that would overcome the substantial deficiencies in the Sellers disclosure with respect to the requirements of Applicant's independent claims. For example, like Sellers, Winkler (USPN 5,345,362 to Winkler) and Kirchgeorg (USPN 6,327,497 to Kirchgeorg et al.) disclose medical devices that include only a single display monitor. The teachings of Winkler and Kirchgeorg clearly would

⁴ *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

⁵ Sellers at column 4, lines 30-50.

⁶ Sellers at column 5, lines 39-41.

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not have motivated one of ordinary skill to modify the Sellers device to include a second display, arrange the displays to face in different directions, and display respective subsets of measured patient parameters via the displays.

Further, Higginbotham does not even disclose a medical device, much less an emergency medical device comprising first and second display monitors to display respective subsets of measured patient parameters. The Examiner failed to identify any teaching in the prior art that would have motivated one of ordinary skill in the medical device arts to look to the consumer electronics messaging device described by Higginbotham for modification of the medical monitor described by Sellers. In the Final Office Action, the Examiner suggested that one of ordinary skill would have been motivated to combine Sellers and Higginbotham for the purpose of continuous viewing of patient parameters. The Examiner has not identified where this motivation can be found in the relevant prior art. It appears that the Examiner plucked this motivation directly from Applicant's own disclosure, which is a clearly improper.

CONCLUSION

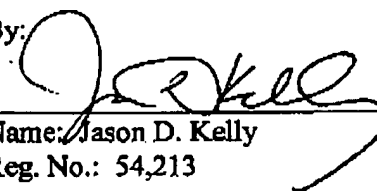
For at least the above reasons, the rejections of the pending claims are clearly deficient, both factually and legally. Applicant requests a review and a panel decision that promptly resolves the issues in Applicant's favor and eliminates the need for an Appellate Brief. Withdrawal of the rejections and prompt allowance of all pending claims is requested. Alternatively, Applicant requests that the Final Office Action be withdrawn, and that Applicant be given a full and fair opportunity to respond to the pending rejections, which are based upon new grounds that were not necessitated by any amendments made by Applicant.

Date:

9/6/05

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